

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS MUELLER, MATTHIAS WANSCHURA  
TORSTEN MLASKO and VOLKER LAUKE

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Application No. 09/816,526  
Technology Center 2600

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Mailed: February 23, 2009

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Before DEBORAH L. PERRY, *Supervisory Paralegal Specialist, Review Team.*  
PERRY, *Supervisory Paralegal Specialist, Review Team.*

ORDER RETURNING UNDOCKETED APPEAL

This application was received at the Board of Patent Appeals and Interferences on September 22, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner.

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The matters requiring attention prior to docketing are identified below.

## **APPEAL BRIEF**

### **Summary Of Claimed Subject Matter**

Appellant filed an Appeal Brief dated October 01, 2007, in response to the Final Rejection mailed October 30, 2006. The Appeal Brief is not in compliance with the new rules of 37 CFR § 41.37(c) effective September 13, 2004. § 37 CFR § 41.37(c) states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

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(c)(1) The brief shall contain the following items...of this section:

(v) ***Summary Of Claimed Subject Matter***. A concise statement of each ground of rejection presented for review.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief. The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

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Section 37 CFR§ 41.37(c) further states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), **an entire new brief need not, and should not**, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

### **CONCLUSION**

Accordingly, it is

**ORDERED** that the application is returned to the Examiner for appropriate action on the following:

- 1) To hold the Appeal Brief filed October 01, 2007 defective

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2) notify Appellants to file a “paper” providing a Summary of the Claimed Subject Matter as required by 37 C.F.R. § 41.37( c )(1)(v), properly addressing all independent claims on appeal. It is unnecessary for appellant to re-file the entire Appeal Brief, a “paper” correcting the Appeal Brief is sufficient;

3) For the Examiner to consider and acknowledge any “paper” filed by Appellant correcting the Appeal Brief, Summary of Claimed Subject Matter; and

4) for such action as may be appropriate.

If there are any questions pertaining to this order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DLP/jgr

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